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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,541

Applicant(s)

THROOP, ROBERT

Examiner

Douglas B. Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 9 recites the limitation "later steps" in line 22 of page 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-34 and 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims must be tangibly embodied.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-4, 7, 9-16, 35-36 and 38-45 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,704,118 to Hull et al..

8. As to claim 1, Hull teaches a method for managing email content, comprising the steps of: electronically monitoring network email for email content (col. 8, lines 27-63); automatically extracting the content (col. 8, lines 27-63); and loading the content to a graphics database accessible from the network (col. 9, lines 30-55).

9. As to claim 3, Hull teaches the method of claim 1, the step of automatically extracting the content comprising extracting electronic documents from the email (col. 8, lines 27-63).

10. As to claim 4, Hull teaches the method of claim 1, the step of automatically extracting the content comprising extracting parsed text from the email (col. 9, lines 30-55).

11. As to claim 7, Hull teaches the step of electronically monitoring comprising periodically polling one or more email inboxes for new messages (col. 8, lines 27-63).

12. As to claim 9, Hull teaches claim 1, further comprising the step of automatically determining an organization associated with the email (col. 8, lines 27-63 and col. 9, lines 30-55).

13. As to claim 10, Hull teaches the method of claim 9, the step of automatically determining an organization comprising automatically comparing the organization with an authorization list (col. 8, lines 51-59, the configuration file).

14. As to claim 11, Hull teaches claim 10, further comprising forwarding the email to an electronic file for error handling in the event that the organization is not within the authorization list (col. 8, lines 27-63 and col. 9, lines 30-55).

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15. As to claim 12, Hull teaches the step of automatically determining an organization comprising the step of interrogating a from-field of the email (col. 8, lines 27-63 and col. 9, lines 30-55).

16. As to claim 13, Hull teaches the method of claim 1, further comprising the step of automatically scanning the email for illegal text strings defined in a predetermined electronic file (col. 8, lines 27-63 and col. 9, lines 30-55).

17. As to claim 14, Hull teaches the method of claim 13, further comprising moving the message with one or more illegal text strings to an electronic file for error handling (col. 8, lines 27-63 and col. 9, lines 30-55).

18. As to claim 15, Hull teaches the method of claim 1, the step of automatically extracting the content comprising the step of converting the email, without enclosures, to a graphics image (col. 8, lines 27-63 and col. 9, lines 30-55).

19. As to claim 16, Hull teaches the method of claim 15, the step of converting the email to a graphics image comprising converting the email to a TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

20. As to claim 42, Hull teaches an email system of the type that processes email for a network, the improvement comprising application software configured with the network for converting email content to graphic images and for storing the graphic images into a graphics database accessible from the network (col. 8, lines 27-63 and col. 9, lines 30-55).

21. As to claim 43, Hull teaches an email system of claim 42, the further improvement wherein the database automatically responds to the storing of graphic images to trigger

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subsequent workflow processes linked with the content (col. 8, lines 27-63 and col. 9, lines 30-55).

22. As to claims 35-36, 38-41, and 44-45, they feature limitations found in the claims rejected above and are thus rejected for the same reasons.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 5, 8, 37, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,704,118 to Hull et al..

25. As to claim 5, Hull teaches a method of claim 1 including the step of loading the content into a graphics database however Hull does not teach loading into a FileNet repository.

Official notice is taken that FileNet is was a well known type of graphics database.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with a FileNet repository because FileNet repositories were well known types of graphics databases.

26. As to claim 8, Hull teaches a method of claim 7, including the step of periodically polling however Hull does not teach polling the email inboxes at about every ten seconds.

Official notice is taken that polling a mailbox at an arbitrary interval, including 10 seconds, was well known at time of the applicant's invention.

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It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with a polling at a random interval because any email system must have some interval to poll for checking for new mail messages.

27. As to claim 37, it is rejected for the same reasons as claim 5.

28. As to claim 46, Hull teaches the process of claim 45; however Hull does not teach it for an insurance claim.

Official notice is taken that it was obvious at the time of the invention to use a computer network to process an insurance claim.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with the processing of an insurance claim because the insurance industry has used computer networks for decades.

29. Claims 2, 6, and 17-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,704,118 to Hull et al. in view of U.S. Patent Number 6,678,705 to Berchtold et al..

30. As to claim 2, Hull teaches the method of claim 1 including the step of automatically extracting the content however Hull does not explicitly teach extracting graphic image attachments from the email.

Berchtold teaches a method of extracting attachments from the email (col. 3, lines 9-38).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with

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Berchtold regarding extracting attachments from the email because attachments allow all sorts of information to be archived (Berchtold, col. 1, lines 19-35).

31. As to claim 6, Hull teaches the method of claim 1, however Hull does not explicitly teach associating the content with business tasks to facilitate automated workflow processes.

Berchtold teaches associating the content with business tasks to facilitate automated workflow processes (col. 4, lines 9-30).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with Berchtold regarding associating content with tasks because such tasks make retrieval of the archived material more efficient (Berchtold, col. 4, lines 9-30).

32. As to claim 17, Hull teaches the method of claim 1, however Hull does not explicitly teach automatically extracting the content comprising the step of interpreting enclosures of the email.

Berchtold teaches automatically extracting the content comprising the step of interpreting enclosures of the email (col. 3, lines 9-38).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with Berchtold regarding extracting enclosures from the email because attachments allow all sorts of information to be archived (Berchtold, col. 1, lines 19-35).

33. As to claim 18, Hull teaches the step of converting the enclosures to one or more graphic images (col. 8, lines 27-63 and col. 9, lines 30-55).

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34. As to claim 19, Hull teaches converting multiple graphic images to a single page graphic image (col. 8, lines 27-63 and col. 9, lines 30-55).

35. As to claim 20, Hull teaches converting multiple graphic images to a single page graphic image comprising converting to a TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

36. As to claim 21, Hull teaches converting each non-graphic image enclosures of the email to one or more graphic images (col. 8, lines 27-63 and col. 9, lines 30-55).

37. As to claim 22, Hull teaches converting multiple graphic images to a single page graphic image (col. 8, lines 27-63 and col. 9, lines 30-55).

38. As to claim 23, Hull teaches converting each of the non-graphic image enclosure comprising converting the non-graphic image enclosure to one or more TIFF images (col. 8, lines 27-63 and col. 9, lines 30-55).

39. As to claim 24, Hull teaches converting to one or more TIFF images comprising converting multiple page TIFF images to a single page TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

40. As to claim 25, Hull teaches the non-graphic image enclosures comprising one or more of spreadsheets, documents, rich text files, and postscript files (col. 8, lines 27-63 and col. 9, lines 30-55).

41. As to claim 26, Hull teaches converting .pdf files to one or more graphic images (col. 7, lines 17-30).

42. As to claim 27, Hull teaches converting the one or more graphic images to a single page TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

43. As to claim 28, Hull teaches converting graphic images to one or more TIFF images.

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44. As to claim 29, Hull teaches converting multi-page TIFF images to a single page TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

45. As to claim 30, Hull teaches the graphic images comprising one or more of .pdf and jpg files (col. 8, lines 27-63 and col. 9, lines 30-55).

46. As to claim 31, Hull teaches converting each .wpd file to a .doc file (col. 8, lines 27-63 and col. 9, lines 30-55).

47. As to claim 32, Hull teaches converting each .doc file to one or more graphic images (col. 8, lines 27-63 and col. 9, lines 30-55).

48. As to claim 33, Hull teaches converting the images to a single page TIFF image (col. 8, lines 27-63 and col. 9, lines 30-55).

49. As to claim 34, Hull teaches the method of claim 1, however Hull does not explicitly teach automatically formulating a overview file summarizing the content stored in the graphics database.

Berchtold teaches automatically formulating a overview file summarizing the content stored in the graphics database (col. 4, lines 9-30).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hull regarding the archiving of email with Berchtold regarding associating content with a summary because such a summary makes retrieval of the archived material more efficient (Berchtold, col. 4, lines 9-30).

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER

Beatriz Prieto